

Remarks

Applicant contends that there is no contact lens case or prior art that teaches or claims a mirror embedded in one of the caps. While applicant concurs with Examiner that there are mirrors embedded in cases for contact lens cases or makeup cases, Applicant respectfully disagrees that the cited prior art teaches or make obvious the present invention.

Claims 6-9 represent similar embodiments of the case as Claims 1-5, but instead of gluing the mirror into the basin, the mirror is held into the basin by the basin walls. In other words, the mirror snaps into the basin and the basin itself holds the mirror in place by compression forces of the molded plastic basin walls and case (depths). For manufacturing and cost reasons this is the way the case is made now and sold. The mirror can be snapped into the basin, forced out of the basin, and then snapped back into the basin.

In the Specification

None.

Rejection Under 35 USC 112

Claim 9 stands rejected under 35 USC 112, first paragraph, as failing to comply with the written description requirement. Examiner claims the phrase “within said basin by the compression forces toward center of the depth of said basin against the depth of said reflective surface” has no support in the original specification. Applicant concedes that the application does not explicitly state that the mirror is retained within the depth of the basin with a “compression force”.

Applicant’s argues that the “embedding” and “adhesion” methods and means taught by the specification are well known in the manufacturing prior arts and that “embedding” involves a process comprising the steps of placing a slightly oversized object into a recess on the surface of

another object, wherein by forcing the slightly oversized object into the recess, compression forces are created by the depth of the recess in order to retain the slightly oversized object in place. This process of embedding, which inherently includes “compression forces”, is well known process in the manufacturing arts.

5 Examiner contents that “the step of embedding does not necessarily require an compression force toward the center of the basin.” In the absence of a compression force created by forcing an oversized reflective surface into the basis, there would be no means of securing the reflective surface to the basin, it would simply be sitting in a recess and would fall out when tilted at an angle or turned over. To secure a reflective surface within a basin of equal or larger
10 size, and adhesive would be needs, while forcing a slightly larger reflective surface into a basin, resulting compression forces between the depths of their respective sides acts to secure the reflective surface within the basin.

 Claim 9 has been amended to read as “said reflective surface is secured within said basin toward the center of the depth of said basin against the depth of said reflective surface.” As
15 described, the contact case of the present invention is molded out of a flexible a polymer (see paragraph 12 of specification). The reflective surface can be secured to the basin in a number of ways, one embodiment would be to glue the reflective lens in the basin or on top of a cap that is flat but has no basin (this is ADHESION). Withdrawal of this rejection is respectfully requested.

 Claim 9 stands rejected under 35 USC 112, second paragraph, as being indefinite and not
20 clear what compression force is exerted toward the center of the depth of the basin. The present invention eliminates the need to use a glue or other adhesive product, instead teaching a cap with a basin that has a larger depth than the reflective surface and is slightly smaller than that of the reflective surface that is to be inserted (this is EMBEDDING). The reflective surface is inserted

into the basin and is held in place by the compression forces exerted against its depth by the depths of the basin walls. During the manufacturing process the reflective surface, which is slightly larger than the basin opening, is forced into the basin under pressure. Once located in the basin, the reflective surface's smaller depth allows it to be held in place by the compression forces of the polymer, which is slightly stretched. Withdrawal of this rejection is respectfully requested.

New claims 12-14 have been added to more specifically claim the adhesion and embedding of the present invention and are request for consideration in this response.

If examiner is still unclear of the claim 9 language or would like to discuss proposed amended claim language to overcome this rejection, Examiner is invited to contact Applicant's Attorney to conduct a phone interview. Withdrawal of this rejection is respectfully requested.

Claims 1-11 stand rejected under 35 USC 112, second paragraph as being indefinite for failing to particularly point out and distinctly claim the subject matter of applicant's invention.

With respect to claim 1, it is unclear where the reflective surface of on line 6 is the same as the reflective outer surface on line 5 or the reflective surface covering on line 4. Applicant has amended claim 1 to clarify that the reflective surface covering has a reflective outer surface, and create uniformity to its recitation in Claim 1. Applicant has amended Claim 1 to correct the antecedent basis for "said basin". Withdrawal of this rejection is respectfully requested.

With respect to Claim 4, ""a basin" has been amended to read "said basin" due to Claim 4's dependency of Claim 1. Withdrawal of this rejection is respectfully requested.

With respect to Claim 6, the term "each reservoir" has been amended to reach "said at least reservoir" as request by the Examiner. Withdrawal of this rejection is respectfully requested.

With respect to Claim 10, amended language now clearly claims the reservoir with threads on its outer surface. Withdrawal of this rejection is respectfully requested.

With respect to Claim 11, "said threads" have been replaced with "the threads". Withdrawal of this rejection is respectfully requested.

5 ***Rejections Under 35 USC 102***

Claims 1, 4 and 6 stand rejected under 35 USC Section 102(b) as being anticipated in view of *Speshyock et al.* (U.S. 3,211,281) hereafter referred to as '281. With respect to claims 1, 4, and 6, Examiner cites '281, stating that it discloses a contact lens case comprising:

- 10 1. base (verified by Fig 1, '281, item 1);
2. cover (verified by Fig 1, '281, item 2);
3. at least one reservoir on the top side of the base having an outer surface (verified by Fig 2, '281)
- 15 4. cover having its own outer surface and attachable to the base via its own threads (verified by Fig 1, '281 item 18);
5. a reflective surface covering said outer surface of said cover(verified by Fig 1, '281, item 5); and
6. said cover having a basin and the reflective surface has a depth less than the basin depth.

20 With respect to claims 1 and 4 anticipation ***requires the disclosure in a single prior art reference of each element of the claim under consideration*** and it is not enough that the prior art reference discloses all the claimed elements in isolation, rather anticipation requires disclosure ***as arranged in the claim***. See. *W.L. Gore & Associates v. Garlock, Inc.* Claims 1, 4, and 6 have been amended to include the language "in combination" explicitly making the claims
25 a specific combination of the elements claimed therein.

Here '281 refers to a 'cover.' The examiner refers to this cover containing a mirror. In Fig. 2 of '281, the cover that '281 refers to is removed, showing the 'lens holding portion.' The 'lens holding portion' is the contact lens case. In the first claim of '281, it also states the

invention has a contact lens holding means, which includes a base and cover that can have a mirror, and the invention has a contact lens storage means, which is the case in the present invention. They are two separate and distinct parts of '281. '281 teaches a mirrored cover case for a contact lens case, while the present invention on teaches a contact lens case wherein mirrors
5 are secured to the removable caps, not to another case.

Column 3, lines 70-75 of '281 discusses the cover; base; and fluid-containing compartments bounded by bottom, sidewall and removable caps. The cover is separate from the removable caps of the fluid containing compartments.

Column 5, line 13 of '281 states that "all the embodiments utilize the same lens holding
10 cap element." This lens holding cap element is not mirrored. The cover can be mirrored. The word "mirror" appears only once in '281 in column 3 line 49.

The examiner's description in the office action closely follows Applicants description on page 2 of the present application and is not supported by '281 or any other cited reference. The mentioned mirrored 'cover' in Examiner's rejections cannot possibly refer to '281 as the 'cover' in
15 '281 is not a threaded connection to the base. The present invention describes a mirrored cover (cap) for a contact lens case. '281 merely describes a mirrored cover for the cover for a contact lens case.

The sixth element in Applicant's claims is not taught, suggested, or anticipated by '281. Examiner provides no citation to the teaching of a cover or cap having a basin wherein the
20 reflective surface has a depth less than the basin depth in '281. '281 teaches a mirrored case that holds a contact lens case (see column 3, line 48), it is *not* a mirrored contact lens case but a case for a contact lens case.

Applicant would again like to emphasize the differences between the present application and the teaching of '281. Specifically, the present application is narrowly focused on a basin on a cap that covers the area for storing a contact lens and is not a case for a contact lens case as that taught by '281. Applicant's invention incorporates a reflective surface on a contact lens case in a unique and non-obvious way, while '218 merely teaches a case comprising two parts, which allow for the storage of a contact lens case and other materials, with one part of the case having a reflective surface. There is no mention of teaching in '218 of how to secure the reflective surface to a case, and '281 does not teach the use of a basin or any specific size. Applicants point is confirmed by Examiner's position on page three of the office action when Examiner states "mirror appears to be attached" (emphasis added). Withdrawal of this rejection is respectfully requested.

Claim 6 stands rejected under 35 USC Section 102(b) as being anticipated in view of *Speshyock et al.* (U.S. 3,211,281) hereafter referred to as '281. Anticipation requires the disclosure in a single prior art reference of each element of the claim under consideration and it is not enough that the prior art reference discloses all the claimed elements in isolation, rather anticipation requires disclosure as arranged in the claim. See. *W.L. Gore & Associates v. Garlock, Inc.* By Examiner's own words, and lack thereof, it is clear that '281 does not teach the use of a basin for receiving a mirror. Examiner has made no citation to such a teaching in '281 and ever further, in under Examiner's Claim Rejections – 35 USC Section 102, Examiner writes "but in the event that it is not attached" clearly an indication the Examiner can not support the required disclosure under 35 USC 102 in '281.

Further anticipation will not be found when the prior art is lacking or missing a specific feature or structure of the claimed invention. Here, as previously discussed, '281 does not disclose the

use of basin to secure the mirrored surface using embedding techniques or compressive pressure from the side wall of a basin as claimed by Applicant. Additionally, '218 does not teach or suggest the specific relationship of the reflective surface and the basin, such that the basin wherein the reflective surface has a depth less than the basin depth is required. Withdrawal of this rejection is respectfully requested.

With respect to Examiner's languid attempt at combining the rejection to Claim 6 on the basis of 35 USC Section 103 without a proper analysis to the 35 USC Section 102 rejection we will address its shortcomings as well.

A prima facie case of obviousness is established when an examiner provides:

1. one or more references
2. that were available to the inventor and
3. that teach
4. a suggestion to combine or modify the references,
5. the combination or modification of which would appear to be sufficient to have made the claimed invention obvious to one of ordinary skill in the art.

Accordingly, an applicant who is able to prove that the Examiner has failed to establish any one of these elements will prevent the prima facie case of obviousness from being established.

Here, Examiner makes no effort to cite a suggestion to combine the mirrored caps taught by '579 and '452 for lipstick cases for use on a contact lens case. Also, with respect to Examiner's allegation that it would be "obvious to secure the mirror to prevent its inadvertent removal from the basin," how does the Examiner know that '281, '579, or '452 didn't contemplate removal? The Examiner can *not* claim it is obvious under '281, '579, or '452 to attach the mirror due to its lack of teaching and the possibility of a desirable effect for removability. Withdrawal of this rejection is respectfully requested.

Rejections Under 35 USC 103

Again for complicity, a prima face case of obviousness is established when an examiner provides:

1. one or more references
2. that were available to the inventor and
3. that teach
4. a suggestion to combine or modify the references,
5. the combination or modification of which would appear to be sufficient to have made the claimed invention obvious to one of ordinary skill in the art.

Accordingly, an applicant who is able to prove that the Examiner has failed to establish any one of these elements will prevent the prima facia case of obviousness from being established.

With respect to Claims 1-11, which stand rejected under 35 USC 103(a) as being unpatentable over Ulmer, et al. ('780) in view of Girard ('597) and/or Amet ('452) applicant respectfully disagrees.

Examiner alleges that '780 discloses "a least one reservoir on the top side of the base and having an outer surface with threads;" A cap for the reservoir is attached to the outer surface of the reservoir by threads." This is clearly a misstatement of the teaching of '780. '780 teaches a cap 18 with a base fixed in such a manner that the cap 18 and base 20 may be removed from a container 14 with the base 20 attached. It is the container 14, which has a mirrored surface 60, not the cap 18. '780 does not suggest or teach the use of a mirrored surface on the cap 18, it only teaches the use of a mirrored surface 60 on the container 14. Thus, Examiner's arguments are not supported.

The cap 18 of '780 is separable from the lens storing area or container 14, which is the basis of improvement for the present invention. The present invention allows a user to remove a cap and use a mirror located on the cap to assist in the asserting of a contact into the eye, while

'780 would require a user to handle and wave around the container 14 while using the mirrored surface 60 of the container 14, which is more difficult to hold steady due to its weight and size with also the potential for spilling the cleaning and sterilization fluid from the container 14.

Examiner makes no effort to cite a suggestion to combine the mirrored caps taught by
5 '579 and '452 for lipstick cases for use on a contact lens case of '780. Also, with respect to Examiner's allegation that it would be "obvious to secure the mirror to prevent if from inadvertent removal from the basin," again, how does the Examiner know that '780, '579, or '452 didn't contemplate removal? The Examiner can *not* claim it is obvious under '780, '579, or '452 to attach the mirror due to its lack of teaching and the possibility of a desirable effect for
10 removability or attachment at a different location. Withdrawal of this rejection is respectfully requested.

With respect to Claims 1, 4, and 5 which stand rejected under 35 USC 103(a) as being unpatentable over De Meo. ('477) in view of Girard ('597) and/or Amet ('452) applicant and/or Official Notice respectfully disagrees.

15 '477 does teach a what could be called a "standard contact lens case" which is well known in the prior art, and is incorporated in the present invention that comprises, at least one reservoir, a base with an outer surface, and an attached cap. Examiner's allegation that '477 "appears to have a mirrored surface" is incorrect. The title, claim and description of the Figures in '477 is absent of any reference to the type of surface or materials. Additionally, the figures
20 themselves show no reflective surfaces. Examiner's position is completely nonsensical in view of all the cited prior art made of record in this prosecution and Applicant's application, all of which clearly illustrate reflective surfaces in their line drawings, while '477 shows one surface appearance for the entire contact lens case. Withdrawal of this rejection is respectfully requested.

Official Notice is also not sufficient to supply motivation for modifications. The factual inquire to modify must be based on objective evidence of records. *Ex parte Humphreys* holds that when an Examiner does not provide specific reasons to support the obviousness rejection, they have failed to establish the prima facie case of obviousness. Here Examiner fails to states
5 the specific element or motivation that is being taken. If it is “to secure the mirror within the cap....” in view of ‘570 or ‘452, then Examiner’s statements are inconsistent as Examiner claims Official Notice on page file first paragraph, but then claims obvious for no reason in paragraph 3. Withdrawal of this rejection is respectfully requested.

With respect to Claim 2-3 applicant concedes that it is known in the prior art to engage
10 the cap to the base of a contact lens by thread as disclosed by Lin ‘314. Applicant respectfully requests withdrawal of these rejections based on the same arguments for Claim 1, from which claims 2 and 3 depend.

With respect to Claims 6 and 9-11 which stand rejected under 35 USC 103(a) as being unpatentable over De Meo. (‘477) in view of Girard (‘597) and/or Amet (‘452) and Lin (‘314).
15 Applicant respectfully requests withdrawal of this rejection based on the same arguments for Claims 1, 4, and 5, which address the failure to establish a proper 35 USC 103 rejection based on the combination of De Meo. (‘477) in view of Girard (‘597) and/or Amet (‘452) in view of the claimed elements of the present invention.

Applicant concedes, with respect to Claims 7, and 8 that the addition of the claim element
20 for engaging the base and cap by threads is disclosed by ‘314 and respectfully requests withdrawal of these rejections based on the same arguments for Claim 6, from which claims 7 and 8 depend.

Conclusion

For all the reasons advanced above, Applicant respectfully submits that the application is in condition for allowance and that action is earnestly solicited.

In the event that an extension of time is required, or may be required in addition to that requested in a petition for an extension of time, the Commissioner is requested to grant a petition for that extension of time which is required to make this response timely.

Respectfully submitted,

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